

Application Number 10/714,758
Responsive to Office Action mailed June 24, 2005

REMARKS

This submission is responsive to the Office Action dated June 24, 2005. Applicant has canceled claim 157 and amended claims 55, 73, and 156. Claims 1-156 and 158-170 remain pending, with claims 1-54 and 88-155 being withdrawn in response to a Restriction Requirement.¹

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 55-87 and 156-170 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0022970 by Noll et al. (Noll). Applicants respectfully traverse the rejections. Noll fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. § 102(e), and provides no teaching that would have suggested the desirability of modification to include such features.

In order to support an anticipation rejection under 35 U.S.C. § 102(e), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."² If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. § 102(e) is improper.³

Further, the Administrative Procedure Act requires that a rejection under 35 U.S.C. § 102(e) be the result of "reasoned decision making," i.e., be supported by a substantial evidentiary record and well-articulated rationale.⁴ The Code of Federal Regulations and Manual of Patent Examining Procedure reflect this requirement, stating that the pertinence of each reference must be clearly explained, and that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.⁵ In other words, to support the rejection of Applicants' claims under section 102(e), the Examiner was obligated

¹ In the Office Action, the Examiner incorrectly stated that claims 1-54 and 88-155 had been canceled by the Amendment filed April 14, 2005.

² See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

³ *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

⁴ See *In re Lee*, 61 USPQ2d 1430, 1432-35 (CAFC 2002).

⁵ 37 C.F.R. § 1.104(c)(2) and M.P.E.P. § 706.

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consider each and every limitation of each of the claims, and provide clear explanation of what teachings in the Noll reference the Examiner believed anticipated each limitation. In the Office Action, the Examiner did not fulfill this obligation.

The claim rejections presented in the Office Action are entirely conclusory; lacking any explanation of their underlying rationale. The forty-eight claims rejected in the Office Action recite a variety of different limitations. Yet, for each of the claims, the Examiner merely asserts that the recited limitations are taught in the reference, and then cites the same portion of the Noll disclosure. It is not at all clear to Applicants whether the Examiner has considered each and every limitation of each of the forty-eight claims, as he was obligated to do.

Moreover, the repeatedly-cited portion of the Noll disclosure does not so clearly teach the limitations recited in Applicants' claims that the Examiner may cite it without explanation. Indeed, a substantial majority of the limitations are not disclosed or suggested anywhere within Noll. Nor are the teachings of Noll so closely related to the subject-matter recited in Applicants' claims that its application to the claims is obvious. For example, Noll is, at best, tangentially related to online commerce, and provides no teaching remotely related to "a commitment by an online entity in...to a selling practice," as required by each of Applicants' independent claims 55, 74 and 83.

Specifically, each of independent claims 55 and 74 requires a method comprising accepting a commitment by an online entity to a selling practice, while independent claim 83 requires a system comprising a data store configured to store data reflecting a commitment by an online entity to a selling practice. Each of claims 55 and 74 further require delivering a media object representative of the commitment for presentment to a user or potential buyer, while claim 83 further requires a server to automatically control whether a media object representative of the commitment is communicated for presentment to a potential buyer. Claim 74 further requires monitoring compliance of the online entity to the commitment, and updating the media object based on the monitoring step. Noll fails to disclose, or even suggest, any of these requirements of Applicants' independent claims.

In view these requirements of Applicants' independent claims, and the portion of the Noll disclosure cited by the Examiner, it appears that the Examiner has misunderstood the teachings of Noll related to "progressive marketing opportunities." In general, a progressive marketing

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opportunity as described by Noll is an advertisement by a brand, store or seller, which may include coupons, rebates, or the like, communicated to a consumer or buyer via a network.⁶ Noll indicates that the buyer may accept the coupon, rebate, or the like, and that acceptance may be communicated to seller, or a third party.⁷

The advertisement presented to a buyer in the Noll system is not representative of any commitment on the part of the seller, much less a commitment to a selling practice, as required in each of Applicants' independent claims. Further, Noll provides no teaching related to accepting a commitment by an online entity to a selling practice, as recited in claims 55 and 74. The only sort of acceptance discussed in Noll is the acceptance by the buyer of the offer found in such advertisements. However, the buyer in the Noll system is not accepting a commitment to a selling practice. Noll similarly fails to suggest a datastore configured to store data reflecting a commitment by an online entity to a selling practice, as required by claim 83. Further, Noll provides no teaching that is even remotely related to monitoring compliance with a commitment to a selling practice and updating a media object based on the monitoring, as required by independent claim 74.

Noll also fails to disclose or suggest a majority of the requirements of Applicants' dependent claims, which leads Applicants to question whether they were considered.

For example, Noll fails to provide any disclosure relevant to a buyer guarantee, as recited in each of claims 57-61, 76, 85, 160-162 and 168-170.

Noll also fails to disclose or suggest an electronic seal, as recited by claim 65, or a seal of certification, as recited by claim 80.

Noll fails to disclose or suggest allowing a user to request information regarding a commitment to a selling practice using a media object, as recited in claim 68, or provide any teaching relevant to specific programs or sub-marketplaces within an online marketplace, as recited in claims 71 and 72.

Noll also provides no teaching relating to use search engines, or display of results generated by a search engine, as recited in claims 73 and 156-159.

⁶ Noll, paragraphs [0050] and [0062].

⁷ Id.

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Noll also provides no teaching relating to monitoring feedback from users of electronic commerce or from online sales activities, as recited by claim 77, or a reputation rating of an online entity, as recited in claim 165.

Noll also fails to provide any teaching relating to an online dispute resolution system, as recited in claim 155.

The preceding examples were not a complete or exhaustive list of the shortcomings of Noll with respect to the dependent claims.

In sum, Noll fails to disclose each and every limitation set forth in claims 55-87 and 156-170. For at least this reason, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 55-87 and 156-170 under 35 U.S.C. 102(e). Withdrawal of this rejection is requested.

Applicant also requests that, to the extent any subsequent Office Action includes rejections of any of Applicants' claims, the rejections are supported by a well-articulated rationale, and refer to the specific teachings within the applied references believed applicable, as required by the Administrative Procedure Act, Code of Federal Regulations, and Manual of Patent Examining Procedure.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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